REMARKS

In the Office Action dated October 19, 2004, claims 1-18, 20, 22 and 25-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Matsushita et al. in view of Storch et al and French. Claims 19, 21, 23 and 24 were rejected under 35 U.S.C. §103(a) based on this combination, further in view of Philips.

These rejections are respectfully traversed for the following reasons.

As extensively discussed in Applicants' previous response, the method and arrangement disclosed and claimed in the present application concern not only monitoring of replacement consumable items, but also preventing an attempt to replace a consumed item in a unit with a replacement consumable that is not authorized for use in the particular unit. This is accomplished, in part, in the method and apparatus of the present application by assigning a list of reference code numbers to replacement consumable items and storing that list in a unit in which the consumable item is used. Each time the consumable unit becomes exhausted and must be replaced, the reference code number of the replacement consumable that is being attempted to be used in the unit is checked against the stored list. This is for two purposes. First, usage of the replacement consumable in the unit is permitted only if a match to one of the numbers in the stored list is found. Secondly, if and when such a match occurs, the stored number that produced the match is "consumed" in the unit. In each of the independent claims, the reference code number is stated to be "consumed" by striking it from the unit (device). Since this reference code number has been struck from the unit, it plays no role whatsoever in any future effort to again replace an exhausted consumable item in the device.

The Matsushita et al reference is intended to achieve similar goals, but does so in a manner that is completely opposite to consuming the reference code number by striking it from the device. In the Matsushita et al reference, each time a replacement product is to be installed in the apparatus in Matsushita et al, its identification number is *added* to the contents of the RAM 204. Thus, the RAM 204 contains a running (i.e. accumulated) list by virtue of continuously updating, by adding numbers, the list stored therein. Although the code number for a consumable may be shifted or moved from one memory to another in the Matsushita et al reference, it is not "consumed" in the manner explicitly set forth in the claims of the present application, by striking it from the device in which the consumable item is to be used.

As argued in Applicants' previous response, striking the identification number of a consumable item from the device disclosed in Matsushita et al would destroy its intended operation, because it is essential to the intended operation of the Matsushita et al system for the reference number in question to be *added* to the contents of the RAM 204.

In previous actions, the Examiner took the position that the Matsushita et al reference taught "consuming" the aforementioned code number. The Storch reference was relied upon by the Examiner as providing other teachings which the Examiner considered relevant to the rejection. Following the amendment of the independent claims to explicit define "consuming" as striking the reference code number from the device, the Examiner has now relied on the French reference, in combination with Matsushita et al and Storch. At page 4 of the Office Action, the Examiner cited column 6, line 25 through column 7, line 15 of the French reference,

as according to the Examiner, providing a teaching to consume a reference code number by striking a reference code number from the device. Applicants are unable to find a teaching even remotely resembling this concept in the cited passage of the French reference, or in any other passage of the French reference. The passage cited by the Examiner merely refers to storing information relating to encryption but there is no teaching in passage that any information related to encryption is struck from the device after it is used for the relevant encryption purposes. Even if this were the case, however, this would merely be a teaching of a generalized concept, in the context of encryption, to make one and only one use of particular encryption information (such as an encryption key). There is no teaching in the French reference or any of the other references of record to make use of such a concept in the completely different context of authorizing replacement of a consumable item. Applicants respectfully submit that if a person of ordinary skill in the field of designing system of authorizing replacement consumable items had the insight to employ teachings relating to encryption, this would be an insight supporting patentability, rather than negating patentability.

More importantly, however, even if the French reference did provide the teachings alleged by the Examiner, modifying the Matsushita et al reference in accordance with those teachings would destroy the intended operation of the system disclosed in Matsushita et al. It is essential for the intended operation of that system that the code number be *added* to the contents of the memory 204. If, by contrast, the code number of a replacement consumable item were struck from the device in Matsushita et al, the ability to prevent future unauthorized use of other replacement

consumable items would be destroyed, because that protection can ensue only by *adding* the reference code number to the contents of the memory 204.

Even before the Examiner cited the French reference, in previous responses Applicants have presented this argument against modification of the Matsushita et al reference by striking the reference code number from the device. The Examiner has never responded to those arguments, but has simply now cited the French reference. As a motivation for modifying the Matsushita et al reference in accordance with the teachings of French (as well as in accordance with the teachings of Storch), the Examiner at page 7 of the Office Action stated such a modification would deter possible theft and prevent additional cost. These are such generalized motivations as to be useless in providing any guidance whatsoever to a person of ordinary skill with regard to modifying the references in question. The alleged motivation cited by the Examiner are simply general goals that every designer of every electronic system has in mind. Because of their generalized nature, thousands if not millions of ways exist in theory by which these goals can be accomplished. Under the requirements of 35 U.S.C. §103(a), a motivation, inducement or teaching must be present in one of the relied-upon references that allegedly guides a person of ordinary skill in the relevant technology toward the specifically claimed invention. Such generalized goals, which do not provide any specific guidance whatsoever, cannot satisfy the evidentiary standards which are necessary to justify a rejection under 35 U.S.C. §103(a). This particularly true where, as here, the proposed modification would actually destroy the intended operation of the primary reference.

The same deficiencies apply to the rejection of claims 19, 21, 23 and 24 based on the Matsushita et al/Storch/French combination, further in view of Philips. Even if the Matsushita et al/Storch/French combination were further modified in accordance with the teachings of Philips, the same deficiencies discussed above would exist.

If the Examiner determines to maintain either of these rejections, the Examiner is respectfully requested to explain how the operation of the Matsushita et al reference, in the intended manner, can be maintained if it were modified to strike a reference code number from the device. In the absence of such an explanation, applicants respectfully submit these rejections should not be maintained.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,

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